

REMARKS

(A) STATUS OF THE APPLICATION

Applicants thank the Examiner for her explanation of the rejections in the Non-Final Office Action dated October 24, 2006.

(I) DISPOSITION OF CLAIMS

- (i) Claims 9-16 are pending in the application.
- (ii) Claims 1-8 have been canceled previously.
- (iii) Claims 9-16 are rejected under 35 U.S.C. § 112, 1st ¶, or 2nd ¶, and 35 U.S.C. § 103(a).

(II) APPLICANTS' ACTION

- (i) Applicants have amended Claims 9-12, and 14-16.
- (ii) Applicants also respond to the above rejections.

In the ensuing discussion, comments under the sub-heading "Examiner's Comments" are attributed to the Examiner. Unless specified, Applicants do not generally agree with the assertions made by the Examiner under that sub-heading. Applicants give their views in the comments under the sub-heading "Applicants' Response."

(B) RESPONSE TO REJECTION UNDER 35 U.S.C. § 112

(I) REJECTION UNDER 35 U.S.C. § 112, 1ST ¶-CLAIMS 9-16

(i) Examiner's Comments

The Examiner has rejected Claims 9-16 because they fail to comply with the written description requirement of 35 U.S.C. §, 1st ¶. Claims description in the Specification must reasonably convey to a person skilled in the relevant art that at the time of filing the patent application, the inventors possessed the claimed invention. And that is not the case here.

Particularly, the Specification does not disclose removing the foil from the transparent coating, such that the entire transparent coating, together with the image, remains on the substrate.

In the previous Office Action Response¹, Applicants claimed that the entire layer is transferred because they do not disclose that (only) a portion of transparent layer is transferred. However, Applicants' citation did not explain how the entire transparent coating is transferred.² In addition, just because the Specification lacks disclosure of transfer of a portion of the transparent coating, it does not mean that "the **entire** transparent coating, together with the image, remains on the substrate."³

(ii) Applicants' Response

Applicants respectfully disagree with the Examiner's assertions and logic above.

First, Applicants particularly refer to, and quote, the 1st paragraph on Page 14 of the Specification:

removing the backing foil from **the transparent coating** which, together with the image, **remains on the substrate**, wherein curing according to process step c') proceeds before and/or after removal of the backing foil. (**Emphasis added**).

Clearly, from the emphasis in the above paragraph, the Specification explicitly and unambiguously states that "the transparent coating. . .remains on the substrate." Nowhere in the Specification do the Applicants state, or even suggest, either to the contrary, or that **only a partial** transparent coating remains on the substrate.

According to the MPEP, "[w]hile there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure."⁴ In other words, the MPEP does not require that the newly added claim limitation track the Specification using the exact the same words, as long as the Specification, viewed as a whole, conveys the claim limitation.

¹ See Response to Final Office Action dated August 15, 2006. It was accompanied by a Request for Continued Examination under 37 C.F.R. § 1.114.

² Applicants referred to Lines 1-3 of Page 14 of the Specification to establish the point.

³ See Claim 1, Element (d); emphasis added.

⁴ MPEP § 2163(I)(B), 2nd ¶. According to Black's Law Dictionary, 7th Ed., the Latin phrase "*in haec verba*" means "in these same words" or "verbatim."

Applicants do not disagree that the exact phrase “entire transparent coating,” as remaining on the substrate, is not found in the Specification. However, Applicants emphasize that the exact phrase “transparent coating” (as remaining on the substrate), is clearly found in the Specification (see the indented paragraph above). From the “plain-meaning” doctrine,⁵ it is evident that if in the disclosure, an item is described as present, without more, it is presumptively present in its entirety. But if the presence of said item were to also include the interpretation that said item is present in its partial form, such inclusion must be made explicitly clear.

Here, the Examiner is suggesting, in effect, that an absence of the word “partial,” as it qualifies the phrase “transparent coating” in the Specification, must mean a presence of said word. Applicants respectfully submit that the logic is counterintuitive. The “plain-meaning” doctrine does not allow for any other meaning for the words of the claim outside their plain meaning, unless the plain meaning is itself inconsistent with the specification. “Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.”⁶

Clearly, without more, a “transparent coating” and an “entire transparent coating” are mutually equivalent. The term “entire” is redundant because it is inherent in the term “transparent coating.” Applicants inserted the term “entire” in Claim 9 in their previous Response, to clarify, and to satisfy the Examiner’s position that Applicants address ambiguity resulting from the phrase “transparent coating,” as it relates to a coating that may partially or fully remain on the substrate, on removal of the backing

⁵ From MPEP § 2111.01 (I), “the words of a claim must be given their “plain meaning” unless such meaning is inconsistent with the specification. Particularly “[d]uring examination, the claims must be interpreted as broadly as their terms reasonably allow.” (*Citing In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, (Fed. Cir. 2004). “This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.” (*Citing In re Zletz*, 893 F.2d 319, 321, 1 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. . .).

⁶ *Id.*

foil. Applicants even cited the same reference point (*supra*) in the Specification to indicate that “transparent coating” means the complete transparent coating.

Applicants further submit that Examples 1 and 2 on Pages 19-21 of the Specification teach the process of the invention.

(I) REJECTION UNDER 35 U.S.C. § 112, 2ND ¶-CLAIMS 9-16

(i) Examiner's Comments

The Examiner has rejected Claims 9-16 under 35 U.S.C. § 112, 2nd ¶ as indefinite because they fail to particularly point out and distinctly claim the subject matter that Applicants regard as their invention.

Particularly, the phrase “transparent coating” is unclear because it does not indicate which transparent coating it refers to, the first transparent coating, or the further transparent coating.

Secondly, in Claim 12, the phrase “curable coating” is unclear and lacks antecedent basis. It is also unclear whether said phrase refers to the first transparent coating or the further transparent coating.

(ii) Applicants' Response

Applicants have amended Claims 9-12, and 14-16 to address the rejection based on 35 U.S.C. § 112, 2nd ¶.

Particularly, Applicants have amended steps b) and e) such that it is now clear whether said Claim 9 refers to the first transparent coating or the further transparent coating. Similarly, Applicants found it necessary to amend Claims 10-11, and 14-16 to address this alleged ambiguity and indefiniteness.

Applicants have also amended Claim 12. It now refers to the curable coating compositions in the context of the first transparent coating or the further transparent coating. Applicants believe that the amendment addresses the antecedent basis issue.

Applicants submit that they have not added any new matter in amending the claims.

(C) RESPONSE TO REJECTION UNDER 35 U.S.C. § 103(A)-CLAIMS 9-16

(I) Examiner's Comments

The Examiner has rejected:

- (i) Claims 9-13 as obvious over U.S. Patent No. 6,527,898 to Nakamura (*hereinafter* "Nakamura") in view of U.S. Patent No. 6,486,903 to Wagner (*hereinafter* "Wagner");
- (ii) Claim 14 as obvious over Nakamura, in view of Wagner, and further in view of U.S. Patent Application No. 2004/0028881 to Yoshihara, *et al.* (*hereinafter* "Yoshihara"); and
- (iii) Claims 15-16 as obvious over Nakamura, in view of Wagner, further in view of Yoshihara, and further in view of U.S. Patent No. 6,245,382 to Shvartsman, *et al.* (*hereinafter* "Shvartsman").

Particularly, Nakamura discloses all elements described in Claim 9, except element b) as it relates to ink-jet printing. However, Nakamura does disclose that pattern layer may be provided by printing, although it does not specifically disclose ink-jet printing. But Wagner discloses a related process wherein printing includes ink-jet printing.

Similarly, Nakamura also renders Claims 10-16 obvious under 35 U.S.C. § 103(a), in combination with Wagner and either Yoshihara, or Shvartsman. Additional limitations distinguishing the claims are found in one of more of the three references other than Nakamura. The claims are therefore rendered obvious by the combinations of references.

(ii) Applicants' Response

Applicants respectfully disagree with the Examiner's assertion of obviousness because her interpretation of what Nakamura discloses is incorrect. And because obviousness of Claims 9-16 depends on Nakamura as the primary reference

(combined with one or more secondary references), Applicants respectfully submit that Claims 9-16 are nonobvious.

Nakamura clearly differs from the present invention, not just because it does not teach ink-jet printing of the image, but more importantly, because it requires an adhesive layer for adhering the image and the equivalent of the transparent coating on the substrate. The present invention does not require an adhesive layer. But the Examiner indicates that the adhesive layer in Nakamura is optional. Applicants disagree with this assertion. Applicants respectfully maintain that, in fact, the adhesive layer in Nakamura is mandatory for the operability of the invention.

Applicants reproduce below Lines 35-44 in Col. 3 of Nakamura for subsequent discussion:

One aspect of the present invention is a **transfer material** which comprises at least a substrate sheet having releasing property, and the above described **protecting layer** formed on one surface of the substrate sheet. Another aspect of the present invention is a **surface protecting sheet** which comprises at least a substrate sheet having no releasing property, the above described protecting layer formed on one surface of the substrate sheet, and an adhesive layer formed on another surface of the substrate sheet. (**Emphasis added**).

From the first paragraph indented above, the Examiner concludes that Nakamura does not require an adhesive layer. Applicants do not disagree that the **transfer material** in Nakamura does not necessarily include an adhesive layer. But that is how Nakamura defines its **transfer material**. It does not mean that the adhesive layer is optional. In fact, the adhesive layer is included in the second paragraph indented above. However, the second paragraph relates to a **surface protecting sheet** and not the **transfer material**. Of course, the **transfer material** does not include the adhesive layer. But the **transfer material** is made to adhere for example, to a molded article, through the usage of an adhesive layer. Applicants reproduce Lines 27-36 of Col. 9 from Nakamura:

The adhesion layer 4 is one which adhere the above described respective layers on the surface of a molded article. The adhesion layer 4 is formed on the part to be adhered to the molded article of the protecting layer 2 or of the picture layer 3. That is, when whole surface is to be adhered, the adhesion layer 4 is formed on the whole surface. And, when a part of the surface is to be adhered, the adhesion layer 4 is formed partially. As the adhesion

layer 4, is a heat sensitive or pressure sensitive resin suitable for the raw material of the molded article is appropriately used.

In other words, Nakamura teaches a backing foil (called a substrate sheet in Nakamura), coated with a transparent coating onto which a picture layer is printed. Up to this point, one could argue that Nakamura and the present invention are similar. However, Nakamura teaches the need for the adhesive layer, which the present invention avoids. Thus, the present invention works contrary to the teaching of Nakamura.

Several examples throughout Nakamura suggest a necessary presence of the adhesive layer. For example, in lines 45-52 of Col. 3, the use of the transfer material is mentioned; the use includes a step of adhering the transfer material along the surface of a molded article. In lines 53-59 the use of the surface protecting sheet is mentioned; the use includes also step of adhering the surface protecting sheet along the surface of a molded article. Figure 1, as well as Figure 2, are described as schematic sectional views showing examples of the transfer material, whereas Figures 5 and 6 are schematic sectional views showing examples of the surface protecting sheet. Each of those figures includes an adhesive layer (4). Applicants respectfully submit that the above discussion and examples must be seen in connection - it is not possible to interpret the transfer material to exist as an adhesive layer-free variant. Of the two variants described within Nakamura, one is a with a picture layer (3) (Figure 1) and the other is without a picture layer (3) (Figure 2). Wherever the picture-including variant and its use are described, the adhesive layer (4) it is necessarily present.

The present invention provides advantages over Nakamura, in that, adhesive material is not needed, the process is simplified, and the optical influence of the adhesive layer on the final product is avoided. The observer can look down on to the substrate surface with the image applied thereon, through the transparent coating on top of the image-covered substrate surface, without his view disturbed or his perception distorted by the optical influence of the adhesive layer between substrate surface and image/transparent coating.

Nakamura in combination with Wagner, Yoshihara, and/or Shvartsman-Claims 14-16

Nakamura is the primary reference. A combination of Nakamura with other secondary references does not change the situation. Since Claim 9 is non-obvious in view of Nakamura, dependent Claims 10-16 are also non-obvious.

Even when the Examiner combines Nakamura with one or more of the secondary references- Wagner, Yoshihara, and Shvartsman-she is not able to remove the deficiencies of Nakamura, in regards to obviating Claim 9 and dependent Claims 10-16. Because the combinations of Nakamura with the secondary references do not teach all elements of Claim 9 and dependent Claims 10-16, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. Applicants do not discuss the two additional criteria required for establishing the *prima facie* case, i.e., suggestion or motivation to combine the references and a reasonable expectation of success from such a combination.⁷

For the foregoing reasons Applicants submit that cited references fail to render the current invention obvious and therefore respectfully request that the Examiner withdraw the rejections and allow the claims.

⁷ From MPEP § 2142, "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

CONCLUSION

In view of the above remarks, Applicants respectfully submit that stated grounds of rejection have been properly traversed, accommodated, or rendered moot and that a complete response has been made to the Non-Final Office Action mailed on October 24, 2006.

Therefore, Applicants believe that the application stands in condition for allowance with withdrawal of all grounds of rejection. A Notice of Allowance is respectfully solicited. If the Examiner has questions regarding the application or the contents of this response, the Examiner is invited to contact the undersigned at the number provided.

Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928.

Respectfully Submitted,

BY:

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